APPENDIX A

Title 35 U. S. Code. Section 112

§ 112. Specification

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

* * * * * * * * * *

Title 35 U. S. Code. Section 145

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may, unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant. (R. S. 4915; 35 U. S. C., 1946 ed., 63.)

Constitution of the United States. Article V

No person shall be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, except in cases arising in the land

or naval forces, or in the Militia, when in actual service in time of War or public danger; nor shall any person be subject for the same offense to be twice put in jeopardy of life or limb; nor shall be compelled in any Criminal Case to be a witness against himself, nor be deprived of life, liberty, or property, without due process of law; nor shall private property be taken for public use, without just compensation.

APPENDIX B

Opinion of U. S. Patent Office Board of Appeals

[Mailed Jan. 29, 1954, U. S. Patent Office, Board of Appeals] Paper No. 24

Appeal No. 367-13
Hearing: January 11, 1954

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Michael Mojzesz Szwarc

Application for Patent filed September 8, 1948, Serial No. 48,339. Production of New and Useful Polymers.

Richardson & David and Richardson, David & Nordon, Ernest Cheslow & Henry C. Parker for appellant.

This is an appeal from the action of the Examiner refusing to allow claims 54 and 55, which are all of the claims now pending in the case, and which replace claims finally rejected.

The appealed claims read as follows:

54. A process for the production of a solid polymer of high thermal stability which is resistant to sulfuric acid and insoluble in many organic solvents, which comprises heating hydrocarbon vapors consisting essentially of para-

xylene at a temperature of about 860°C. for a period of from about 0.3 to 0.4 second and under a pressure of from about 8 to 10 mm. of mercury, cooling the resulting vapors to a temperature at which a solid polymer is deposited which does not soften even when heated to about 270° C, and recovering the said solid polymer.

55. The solid polymer produced by the process of claim 54.

The subject matter of the appealed claims is sufficiently described in the claims themselves. The sole reason for rejection of the claims is based on the Examiner's holding that the original description of this case does not comply with the requirements of the statutes with respect to a statement of utility of the claimed subject matter. The significant portion of the statute is the first paragraph of Section 112 of the Patent Act of 1952. This paragraph does not differ materially from the significant portion of the prior statute. The paragraph reads as follows:

> "The specification shall contain a written description of the invention, and of the manner and process of making *and using it*, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make *and use the same*, and shall set forth the best mode contemplated by the inventor of carrying out his invention." (emphasis added).

Appellant insists that the original description is sufficient to comply with the statute, asserting that any one skilled in the art would be immediately aware of the utility of the polymer product resulting from the disclosed process.

Appellant has added certain amendments to the specification, relating to the question of utility, and the Examiner has held that such amendments are new matter and therefore not available to provide a compliance with the statute. Appellant insists that the additions are not new matter

and that he does not rely on such additions to escape the charge of insufficiency of disclosure. Appellant's Brief contains the following statement:

> "Applicant wishes to repeat here that the sufficiency of his disclosure with respect to utility does not depend on the admissibility of the alleged 'new matter'. The specification has been amended for emphasis and clarification on the question of utility."

We will consider the description as originally filed and we will also consider the significance of the subject matter added by way of amendment. Appellant first calls attention to the first sentence of the specification which refers to "useful polymers." The mere assertion that the subject matter is useful, like an assertion that such subject matter is novel and inventive is not controlling and does not satisfy the requirements of the statute. At this point there has been added a statement referring to the production of "polymer films" which possess certain qualities. The reference to films is derived from statements in each of the examples. Example 1 includes a statement that the "polymerized product was deposited in the form of a white occasionally transparent film." This deposition takes place on the interior walls of the trap which apparently operates as a condenser-receiver and is maintained at a temperature of 0°C. and the film formation takes place by deposition from a vapor heated to a temperature of 860°C. The noun "film" is defined in the Standard dictionary as:

> "film, n. a slight viscous, watery, or opaque coating or layer; a thin membrane; a pellicle; as a film of oil. 2. Phot. (1) A thin coating of sensitized material spread upon some support for receiving a picture by the agency or any one of many processes; also, the same coating including the picture after its production. (2) a flexible support, as a celluloid, to receive a sensitized coating for making pictures; also, the support bearing the complete picture. (3) Hence, a narrow strip of such sensitizing material for the photographing and

reproduction of a series of pictures as in the motion-picture; colloquially, the motion-picture itself; 3. A delicate filament, as a cobweb."

The apparent conclusion to be drawn from the words used in the examples is that the product is deposited on the interior surfaces of the walls of the receptacle used as a receiver for the condenser and we do not believe that such words are to be interpreted as suggesting the formation of a self-sustaining film. The suggestion to the latter effect, embodied in the amendment, page 1 line 2 of the specification, appears to us to be new matter. The statement that a polymeric material is deposited in the form of a film or layer on the interior surfaces of a receptacle does not imply the formation of a useful self-supporting film. The insertion at page 6 below line 6 to the effect that the polymers produced in accordance with the examples form continuous films which may be stripped from the trap to produce self-supporting flexible tubes is likewise not supported by the statements concerning the formation of a film in the original specification. The reference to the use of a tubular trap in the amendment under discussion is likewise not supported by the original description. Specimens purporting to illustrate such self-supporting flexible tubes of the polymer have been presented in the record and supported by an affidavit executed by appellant. The affidavit states in substance that the films thus submitted were produced in actual experiments of the type disclosed in the specification. The specimens thus submitted can hardly be characterized as tough, coherent or self-supporting and flexible since the specimens are so fragile that one was broken when removed from the envelope for inspection.

A third insertion has been presented at the end of the specification referring to the preparation of protective film coatings. It is asserted in the brief that such coatings possess obvious utility by reason of their resistance to attack by sulphuric acid and by familiar organic solvents

and their thermal stability. The suggestion that the same experiment, that is the formation of a deposit on the interior of a receptacle is illustrative of the formation of self-sustaining films and also the formation of protective coatings is in our opinion self-contradictory. An essential characteristic of a protective coating is adequate adherence to the base on which it is applied. In forming a self-sustaining film it is essential that adherence to the base be avoided. While we are well aware that protective coatings and self-supporting films have been prepared from compositions containing the same film forming material (such as for example nitro-cellulose) special compounding and special methods of application must be employed to obtain these two divergent results. Compositions useful to form protective coatings are ordinarily applied in the form of mobile liquid compositions which thereafter become solidified either by removal of solvent or chemical changes in the coating materials. In the present instance it would appear impossible to employ the polymer as a coating material since it appears to be insoluble in familiar solvents and possess such a great degree of thermal stability as to be apparently infusible.

We have carefully reviewed the specification in the light of the contentions and explanations advanced on appellant's behalf but are of the opinion that the description does not provide an adequate compliance with the requirements of 35 U.S. Code, Sec. 112. We are also of the opinion that the insertions presented for entry into the specification are not derivable from the description as originally filed and therefore embody new matter. The affidavit presented in support of some of this subject matter cannot be used for that purpose. Toupet-Taylor Engr. Co. v. Red Dog Mfg. & Supply Co., 1928 C.D. 220. The question is not whether appellant actually completed an invention prior to filing this case but whether the description of this case provides a proper compliance with 35 U.S. Code, Sec. 112. The Examiner has cited and relies on *In re* Bremner

et al., 638 O.G. 6; 37 C.C.P.A. 1032; 1950 C.D. 342; 182 F. (2d) 216; 86 USPQ 74.

Appellant directs attention to the statement of the Court to the effect that "the law requires that there be in the application an assertion of utility and an indication of the use or uses intended." Appellant suggests that the statement of the introductory sentence of the description referring to "useful polymers" is an assertion of the utility and that the statement concerning the deposition of the polymer in the form of a film on the interior surfaces of the trap is a sufficient indication of utility. We do not believe the Court's language is to be construed as indicating that a bare "assertion" of utility and an "indication" such as the deposition of a film constitutes a proper compliance with the requirements of the statute. We believe that the statement that a hard resin was produced by Bremner et al. constitutes as much of an "indication" of utility as does the reference to the deposition of a film in the present description.

Appellant has cited and discussed a number of decisions which are obviously based on distinct facts. We believe that the words of the statutes are controlling in the present instance.

The decision of the Examiner is affirmed.

/s/ E. W. Geniesse
Examiner-in-Chief
/s/ (Illegible)
Examiner-in-Chief
/s/ M. W. Tucker
Examiner-in-Chief
(Acting)

Board of Appeals

January 29, 1954

Henry C. Parker
National Press Bldg.
Washington 4, D. C.

Opinion of U. S. Patent Office Board of Appeals on Petition for Reconsideration

[Mailed Mar. 18, 1954, U. S. Patent Office, Board of Appeals] Paper No. 26

IN THE UNITED STATES PATENT OFFICE

BEFORE THE BOARD OF APPEALS

Ex parte Michael Mojzesz Szwarc

Application for Patent filed September 8, 1948. Serial No. 48,339. Production of New and Useful Polymers.

Richardson, David and Nordon, Ernest Cheslow & Henry C. Parker for appellant.

ON PETITION FOR RECONSIDERATION

Petitioner requests reconsideration of our decision of January 29, 1954 wherein we affirmed that of the Examiner in rejecting all of the claims pending in the case.

Petitioner presents a somewhat more extended argument relating to the same question of whether or not the present specification contains a written description which satisfies the requirement of the statute particularly as interpreted by the Court of Customs and Patent Appeals in the *In re* Bremner et al. case cited by us. Petitioner does not present any arguments distinctly different from those heretofore presented and considered by us. We have completely stated our position in the decision and no useful purpose would be served in reiterating the substance of that decision.

The petition has been considered but is denied with respect to making any change in our decision.

/s/ E. W. Geniesse
Examiner-in-Chief
/s/ (Illegible)
Examiner-in-Chief
/s/ M. W. Tucker
Examiner-in-Chief
(Acting)

Board of Appeals

March 18, 1954

Henry C. Parker
National Press Bldg.
Washington 4, D. C.

Memorandum Opinion of District Court

[Filed June 21, 1956]

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

Civil Action No. 1602-54

PETROCARBON LIMITED, *Plaintiff*

v.

ROBERT C. WATSON, Commissioner of Patents,
Defendants

MEMORANDUM

This is an action against the Commissioner of Patents under Section 145 of Title 35, U. S. C. Unlike the usual case under this section, however, there is no issue of patentability. The sole issue is whether the *specification* meets the requirements of Section 112 of Title 35 for a written description of the manner of *using* the invention.

The Board of Appeals relied upon the case of *In Re Bremner, Taylor and Jones,* 182 F. 2d 216, to support its holding. There, the Court stated:

> It is our view that no 'hard and fast' ruling properly may be made fixing the extent of the disclosure of utility necessary in an application, but we feel certain that the *law requires that there be in the application an assertion of utility and an indication of the use or uses intended.* [sic]

The question, it would appear, is a close one. However, as was said in *Abbot* v. *Coe,* 71 App. D.C. 195, 197 " 'While the judgment of Patent Office officials is not absolutely binding on the Courts, it is entitled to great weight, and is to be overcome by clear proof of mistake.' " †

Finding, therefore, no "clear proof of mistake," the Court concludes the ruling of the Patent Office should remain, as a consequence, undisturbed.

Order accordingly.

/s/ MATTHEW F. MCGUIRE
United States District Judge

June 21, 1956

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† See also Mississippi Valley Barge Line Co. v. United States, 292 U.S. 282, 286, 287.

Opinion of the Court of Appeals

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 13,675

PETROCARBON LIMITED, APPELLANT,

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS, APPELLEE.

Appeal from the United States District Court for the District of Columbia

Decided July 3, 1957

Mr. Ralph H. Hudson for appellant.

Mr. Arthur H. Behrens, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before BAZELON, WASHINGTON and BURGER, Circuit Judges.

WASHINGTON, *Circuit Judge:* This is a patent case, in which the Patent Office rejected an application on the ground that it did not meet the requirement of 35 U.S.C. § 112 (1952) that it contain "a written description of the invention, and of the manner and process of making and *using* it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and *use* the same." (Emphasis added.) Plaintiff-appellant, as assignee, brought suit in the District Court under 35 U.S.C. § 145 (1952). After hearing, the District Court dismissed the complaint. This appeal followed.

The application claimed an invention consisting of a process for the production of "new and useful polymers."

Various processes were described, using different chemical vapors. The specification said, in part:

> "Polymerization takes place spontaneously on condensation of the monomer vapour by cooling. The cooling may take place in contact with a cool surface on which the polymer is deposited in the form of a film."

Several examples were given in the application "of processes for the production of new polymers in accordance with the invention." The first example given concludes by saying:

> "The vapours leaving the tube were passed into a trap in which they were cooled to 0° C in contact with a cold surface on which the polymerised product was deposited in the form of a white occasionally transparent film."

Example 4 reads as follows:

> "1.4 dimethyl naphthalene vapour at a pressure of about 10 mm.Hg. was passed through a tube heated to 860° C at such a rate that the vapour was subjected to this temperature for from 0.3 to 0.4 seconds. The vapours leaving the tube were passed through a trap in which they were cooled to room temperature. The polymerised product was deposited in the trap in the form of a white film."

The application then went on to say:

> "All the polymers obtained in the above examples were useful because they had great thermal stability and did not soften when heated to a temperature of 270° C. They were not attacked by sulphuric acid at 150° C. They were insoluble in, and also did not swell visibly in, boiling
>
> ethyl alcohol
> diethylether
> chloroform
> xylenes
> benzene
> toluene
> glacial acetic acid."

Plaintiff-appellant argues that the quoted matter amounted to a sufficient disclosure of the utility of the claimed invention within the rule of *In re Bremner*, 37 C.C.P.A. (Patents) 1032, 182 F.2d 216 (1950), namely, that "*there be in the application an assertion of utility and an indication of the use or uses intended.*" (Emphasis in original.) Plaintiff urges on brief that "the description [in the application] of how to make a film, plus mention of its acid resistance and similar attributes, cannot fail to suggest or indicate to those skilled in the art that the film *ought* to be useful, for example, as a protective film or coating." In the District Court plaintiff offered not only a number of tangible exhibits, showing objects protectively coated by the new polymers, but also the testimony of expert witnesses "to explain what the term film meant, and to show this exhibit is made in conformity with the specification, and that they did actually protect, and were functional." The District Court excluded the proffered testimony. In this court the Patent Office in effect concedes that the proffered exhibits and testimony would show that the new polymers do adhere to certain surfaces and protect them against certain acids and other substances.

While the case is a difficult one, we have concluded that we must affirm the judgment of the District Court. Although the specification does say that the "polymers obtained in the above examples were useful" because they had great thermal stability and resisted various fluids, it is not apparent from the face of the specification how utility could in fact be achieved. The examples indicate that the polymer forms a "film"; but they do not indicate whether or not this film adheres to the object on which it forms, whether it falls off in the form of a powder, whether it is detachable in the form of a film-like substance (similar perhaps to cellophane), whether the film of polymer is useful as such, whether it would have to be subjected to further processing before it could form a useful object or fluid, and so on. Some such further indication, it seems to us,

should have been given to enable readers of the application to understand how the product is to be used. If the specification had indicated a particular use for the *film*, and if the question before us was whether the language used was sufficient to explain this use to one skilled in the art, then testimony of experts might well have been received. But the present specification, while indicating useful properties of the new polymers (heat and acid resistance), makes no such statement as to the film, or explains how the film is to be used. Since the word "film" by itself does not connote a particular use, the specification is defective as a matter of law.

Under these circumstances, it was not possible for the plaintiff to remedy the defects in its specification by offering testimony in its *de novo* action in the District Court that in fact the film adhered to objects suspended in vapor; that it was a solid and durable film; and that it was useful as a permanent protective coating. The District Court did not err in excluding the proffered testimony.

For these reasons the judgment of the District Court will be

Affirmed.

BURGER, *Circuit Judge*, dissenting: I dissent because I think it is unsound to say that as a matter of law "the word 'film' by itself does not connote a particular use. . ."

The statute[1] requires a description of utility which is sufficient "to enable any person skilled in the art to which it pertains . . . to . . . use the same . . ." Appellant offered to prove by expert testimony, *i.e.*, "persons skilled in the art" that they understood what the term meant; in other words, that as used in the specification the term disclosed an obvious use and utility, especially when considered in light of the chemical properties ascribed to the substance by the specification. The District Court should have permitted

[1] 35 U.S.C. § 112 (1952).

appellant an opportunity to make good on this offer of proof and then evaluated the testimony before deciding the case.

Judgment of the Court of Appeals

Filed July 3, 1957

Appeal from the United States District Court for the District of Columbia

Before: BAZELON, WASHINGTON and BURGER, Circuit Judges.

JUDGMENT

THIS CAUSE came on to be heard on the record from the United States District Court for the District of Columbia, and was argued by counsel.

ON CONSIDERATION WHEREOF, It is ordered and adjudged by this Court that the judgment of the said District Court appealed from in this cause be, and the same is hereby, affirmed.

Dated: July 3, 1957.

Per Circuit Judge Washington.

Separate dissenting opinion by Circuit Judge Burger.